

REMARKS

In response to the Office Action of June 16, 2005, Applicants have amended the claims, which when considered with the following remarks, is deemed to place the present application in condition for allowance. Favorable consideration and allowance of all pending claims is respectfully requested. The amendments to the claims have been made in the interest of expediting prosecution of this case. Applicants reserve the right to prosecute the same or similar subject matter in this or another application.

Claims 1-18 are pending. By this Amendment, Claims 1 and 10 have been amended and Claims 19-35, which were withdrawn from consideration due to a restriction/election requirement, have been canceled herein without prejudice. Applicants respectfully reserve the right to file one or more divisional applications to Claims 19-35. Claim 10 has been amended to conform the language to be consistent with the language of Claim 9, from which it depends. Accordingly, Claims 1-18 are now under examination in this case. Applicants respectfully submit that no new matter has been added to this application. Moreover, it is believed that the claims as presented herein places the application in condition for allowance.

An indication by the Examiner that Claims 4, 6-12 and 15-18 are allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims is noted with appreciation.

The Examiner has objected to the drawings because they fail to show part 234 as described in the specification (see page 21). The specification has been amended to correct a typographical error on page 21 and reflect that part 234 is, in fact, part 324, i.e., hydrodynamic test apparatus 324, as shown in Figure 3. The amendment is believed to be consistent with the

hydrodynamic test apparatus set forth in the same paragraph which is stated as part 324.

Accordingly, withdrawal of the objection is respectfully requested.

The Examiner has objected to the specification for certain informalities, namely, including the serial number and filing date of the referenced patent application on page 16. The specification has been amended in a manner believed to obviate the Examiner's objection. Accordingly, withdrawal of the objection is respectfully requested.

The Examiner has rejected Claim 5 under the second paragraph of 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, it is the Examiner's apparent belief that Claim 5 is indefinite as there is nothing in the specification that states that all three tests are done sequentially. However, as pointed out in *Northern Telecom, Inc. v. Datapoint Corp.*, 15 USPQ2d 1321, 1326 (Fed. Cir. 1990), the original claims as filed are part of the specification and may provide or contribute to compliance with Section 112. Accordingly, since original Claim 5 of the specification states that all three tests are done sequentially, the claimed method wherein the extreme pressure, hydrodynamic and corrosive wear tests are conducted sequentially in accordance with the program control can be found within the specification as filed. Such being the case, Claim 5 is believed to be fully definite as to comply with the requirement for the second paragraph of 35 U.S.C. §112.

The Examiner has rejected Claims 1, 2, 13 and 14 under 35 U.S.C. §102(b) as being anticipated by Boffa et al. U.S. Patent No. 6,235,691 ("Boffa").

Nowhere does Boffa disclose or suggest "a high throughput method for screening lubricating oil compositions, under program control, comprising the steps of (a) providing a plurality of different lubricating oil composition samples comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive; (b) measuring wear stability of each sample to provide wear stability data for each sample; and (c) outputting the results of step (b)" as presently recited in Claim 1.

Rather, Boffa discloses a lubricating oil composition that has improved fuel economy and wear performance. Boffa further discloses that the lubricating oil compositions can be tested for wear performance using the ASTM Sequence IIIE test. However, it is well established that for a claim to be anticipated a single prior art reference must disclose each and every element of the claimed invention. *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 USPQ2d 1766, (Fed. Cir. 1987). At no point is there any disclosure in Boffa of a high throughput method for screening a plurality of different lubricating oil composition samples by measuring wear stability of each sample to provide wear stability data for each sample, under program control, and outputting the results. As such, Claims 1, 2, 13 and 14 clearly possess novel subject matter relative to Boffa. Accordingly, withdrawal of the rejection under 35 U.S.C. §102(b) is respectfully requested.

The Examiner has rejected Claim 3 under 35 U.S.C. §103 (a) as being obvious over Boffa in view of Holgado et al. U.S. Patent No. 4,209,414 (“Holgado”).

There is likewise no suggestion, motivation or even a hint in Boffa of “a high throughput method for screening lubricating oil compositions, under program control, comprising the steps of (a) providing a plurality of different lubricating oil composition samples comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive; (b) measuring wear stability of each sample to provide wear stability data for each sample; and (c) outputting the results of step (b)” as presently recited in Claim 1, from which Claim 3 ultimately depends. Moreover, there is no suggestion or motivation in Boffa of a high throughput method wherein the step of measuring wear stability further comprises the step of selectively changing a variety of conditions for measuring wear stability in accordance with the program control, the variety of conditions being selected from the group consisting of duration of the at least one test, load generated during the at least one test, acid amount delivered during the at least one test and a combination thereof as presently recited in Claim 3.

Rather, Boffa simply discloses that lubricating oil compositions based on a poly alpha olefin base oil and an ester of phthalic acid have improved fuel economy and wear performance and can be tested for wear performance using the ASTM Sequence IIIE test. It is not seen where in Boffa there is any appreciation of a high throughput method for screening a plurality of different lubricating oil composition samples by measuring wear stability of each sample to provide wear stability data for each sample, under program control, and outputting the results, much less selectively changing a variety of conditions for measuring wear stability in accordance

with the program control, the variety of conditions being selected from the group consisting of duration of the at least one test, load generated during the at least one test, acid amount delivered during the at least one test and a combination thereof. Thus, nothing in Boffa would lead one skilled in the art to modify the lubricating oil compositions disclosed therein and arrive at the claimed high throughput method.

Holgado does not cure the above-noted deficiencies of Boffa. Rather, Holgado simply discloses a dual purpose hydraulic fluid for use in metal cutting operations. There is no suggestion, motivation or even a hint in Holgado of a high throughput method for screening a plurality of different lubricating oil composition samples by measuring wear stability of each sample to provide wear stability data for each sample, under program control, and outputting the results as presently recited in Claim 1. Nor, for that matter, is there any suggestion or motivation of a “high throughput method ... wherein the step of measuring wear stability further comprises the step of changing a variety of conditions for measuring wear stability in accordance with the program control, the variety of conditions being selected from the group consisting of duration of the at least one test, load generated during the at least one test, acid amount delivered during the at least one test and a combination thereof” as presently recited in Claim 3. Thus, even by combining the disclosures of Boffa and Holgado, one skilled in the art would not even arrive at the claimed high throughput method. Accordingly, Claim 3 is believed to be nonobvious, and therefore patentable, over Boffa and Holgado.

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Amdt. dated August 26, 2005
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For the foregoing reasons, Claims 1-18 as presented herein are believed to be in condition for allowance. Such early and favorable action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael E. Carmen", written in a cursive style.

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